

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed July 20, 2009. Currently, claims 9, 12, 16, 17, and 19-23 remain pending. Claims 9, 12, 16, 17, and 19-23 have been rejected. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 9, 12, 16, 17, and 19-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin et al. (U.S. Published Patent Application No. 2003/0125751), hereinafter Griffin, in view of Muni et al. (U.S. Patent No. 5,316,706), hereinafter Muni. After careful review, Applicant must respectfully traverse this rejection.

With respect to the Response to Arguments, the position asserted by the office action would appear to rely upon either “inherent” capabilities of the Griffin reference in response to the “right conditions”, which inherency has not been shown, or to an impermissible alteration of the operating principle of Griffin which appears to require that the catheter pass distally well beyond engagement surface 29 which cannot function as a distal stop as that term is used in the pending claims. Muni appears to be relied upon solely for the purpose of providing a tip comprising an amorphous polymer and a radially extensible distal portion comprising a locally crystalline portion.

As characterized in the office action, engagement surface (29) of Griffin provides a distal stop. As described in the cited paragraph [0187] a stop on the guidewire abuts and stops the filter and not the elongate tubular member (210) or the tip (11) of Griffin. At all times, the filter of Griffin appears to be interposed between the engagement surface for the filter and the tip. During retrieval, the distal end of the elongate tubular member of Griffin passes the tip, the filter, and the engagement surface. The engagement surface does not appear to come in contact with the tip or with the elongate tubular member at any time and so does not appear to function as a stop therefor. As described in paragraph [0187] and depicted in Fig. 6(c), the guidewire lumen (7) of catheter body (2) of catheter (1) appears to be everywhere of greater inner diameter than the first diameter

of the guidewire and additionally to be everywhere greater than the second diameter of the guidewire, said by the office to provide a distal stop. This relationship may be seen in Fig. 6(c) in which the engagement surface (29) has a diameter approximately three times that of the adjacent guidewire (21) and the lumen (7) has a diameter approximately 10 times that of the guidewire (21). Accordingly, the inner diameter of the distal end of guidewire lumen (7) is approximately ten times the diameter of the guidewire, the first diameter of claim 9 rather than being of "substantially the same magnitude as the first diameter". (A ratio of approximately 8:1 is depicted in Fig. 49 which was also cited by the office.) Although the claim refers to the diameter of the guidewire lumen of the elongate tubular member, the office appears incorrectly to have made reference to the larger of two lumen diameters associated with the shank (9) which apparently is advanced by the office as corresponding to the tip of the pending claims, said shank lumen is contained within the lumen (7) of catheter body (2) of catheter (1) thereby confirming that the lumen (7) of the catheter body is much larger than the first diameter of the guidewire of Griffin. The various diameters of lumens associated with the shank are irrelevant to this phrase within claim 9. Accordingly, the lumen of the catheter of Griffin does not appear to "snuggly encompass the diameter of the guidewire" as asserted by the office. For at least this reason, the disclosure of Griffin fails to disclose all elements of claim 9.

The office then asserts that the tip is "perfectly capable of inverting proximally into the lumen if enough pressure is applied to the tip when it abuts an object such as the guidewire stop". Applicants respectfully disagree. Initially, it should be noted that the hypothetical contact with the guidewire stop cannot occur in the apparatus of Griffin because of the intervening filter. More importantly, the disclosure of Griffin, in each embodiment, appears to teach a tip which compresses if necessary and withdraws within the catheter lumen as it must to allow the lumen (7) to extend beyond the tip to engulf the filter for removal. See for example, Fig. 6(c), the unlabeled lower illustration accompanying Fig. 7 on sheet 10, Figs. 13, 13(b), 14, 16, 18, 18(b), 23, 23(b), 26, 28, 30, 33, 38, and 45 which indicate that the principle of operation of Griffin is to withdraw the tip, with optional radial compression, well within the catheter. At no time does the distal tip of Griffin appear to invert, that is to say at no time does the radially inextensible distal

portion such as element (202) of Fig. 49 precede the soft portion (31) of the tip into the lumen (7). For at least this reason, Griffin appears to teach a shank which slides proximally within the catheter lumen to expose a portion of the lumen which is capable of receiving the filter in a collapsed state. This action is described in paragraphs [0266] and [0267]. Were the shank to be prevented from sliding within the catheter, it would become unsuited for its intended purpose of opening the distal portion of the lumen. Further, were the shank to be fixed to the distal end of the catheter to provide sufficient resistance to sliding to allow the inextensible distal portion to be urged into the softer region thereby accomplishing even a partial inversion, this would appear to impermissibly alter the principle of operation of the device of Griffin. (MPEP 2143.01, V and VI) Even in the embodiment of Fig. 45 in which the tip appears to collapse, it does not invert. The ability to invert is not inherent and may not be relied upon as the basis of a rejection.

As noted above, the addition of the polymers of Muni does not appear to overcome the identified deficiencies of the Griffin reference. For these and other reasons, Griffin in view of Muni does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness and Applicants respectfully request that the rejection of independent claim 9 be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 12, 16, 17, and 19-23, which depend from nonobvious independent claim 9, also are believed to be nonobvious and Applicants respectfully request that the rejections be withdrawn.

In the Response to Arguments, the Examiner raised issues which have discussed above. In addition, the Examiner has suggested adding structural language to the claim. While Applicants gratefully acknowledge the attempt to be helpful, it is unclear what structural language the Examiner believes may be necessary or even desirable given the multiple distinctions between elements of claim 9 and the disclosure of Griffin or Griffin

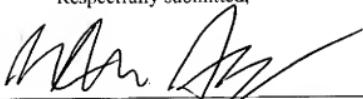
in view of Muni.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date:

Oct. 7, 2009



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